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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,957	05/04/2005	Khaledul M. Islam	PAT 800W-2	8092

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EXAMINER	
GOEL, DINESH K	
ART UNIT	PAPER NUMBER
2419	

NOTIFICATION DATE	DELIVERY MODE
12/05/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/533,957	ISLAM ET AL.	
	Examiner	Art Unit	
	DINESH GOEL	4134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 May 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *04 May 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *12/28/07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

INTERVIEW SUMMARY

As per the telephone interview, the previous non final office action dated 2/20/2008 is hereby withdrawn and is replaced by this supplementary non final office action.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper (U.S. Patent Publication No. 2003/0129979) in view of Khare et al (U.S. Patent Publication No. 2002/0065067).

Referring to claim 1, Cooper teaches a mobile device comprising: a transceiver ("84" in Figure 2) for exchanging information with the wireless networks; a memory ("82" in Figure 2); a blacklist (Cooper reads Avoidance Data list in Figure 2) provided in the memory; and a processor ("80" in Figure 2) for updating the blacklist (Figure 2, paragraphs 0027, 0033).

Cooper does not teach the blacklist identifying wireless networks that do not provide specifically packet data services to the mobile device.

However, Khare et al teach a method which identifies wireless networks that do not provide packet data services and updates SID/NID database to set data availability indicator to indicate data is not available on the network (Figure 7 - step 732, Paragraph 0087, having a separate blacklist based on these data service rejections is simply a matter of design choice).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to have modified the teachings of Cooper with the teachings of Khare et al. The motivation would have been to use a method identifying wireless networks that do not provide packet data services and to avoid those networks to allow a mobile device to acquire a wireless network more efficiently for data applications.

Referring to claims 4 and 5, Cooper teaches a method for a mobile device having a blacklist (avoidance data list) comprising: detecting a wireless network (Paragraph 0026); examining the blacklist stored on the mobile device (Paragraph 0026); if the detected wireless network is listed in the blacklist, refraining from making any call attempts for a predetermined period of time (Figure 2, Paragraph 0033).

Cooper does not teach this with respect to packet data services. However, Khare et al teach a method to determine whether a wireless network provides data services to the mobile device, and updates SID/NID database to

set data availability indicator to indicate data is not available on the network (Figure 7, Paragraphs 0083-0087).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to have modified the teachings of Cooper with the teachings of Khare et al. The modification would allow improving the efficiency by preventing a mobile device from attempting to acquire wireless networks which did not provide data services.

Referring to claim 6, Khare et al do not explicitly teach the method wherein the step of determining whether the wireless network provides packet data services to the mobile device may also comprise the step of authenticating the mobile device on the wireless network, however, it is implied that the step of determining whether the wireless network provides packet data services to the mobile device may also comprise the step of authenticating the mobile device on the wireless network (Paragraphs 0083-0086).

3. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper (U.S. Patent Publication No. 2003/0129979) in view of Khare et al (U.S. Patent Publication No. 2002/0065067) and further in view of Daly (U.S. Patent No. 6122503).

Referring to claim 2, Cooper further teaches wherein the packet data services blacklist includes an element selected from the group consisting of: a

system identifier and network identifier for each blacklisted wireless network (Paragraph 0031); a timer value or an age timer for each blacklisted wireless network (Paragraph 0031, Cooper teaches Avoidance Time).

Cooper as modified does not teach a flag indicating whether an identification of a blacklisted wireless network has been passed to a server.

However, Daly teaches such a flag (reads status indicator) which may be used to indicate that blacklisted wireless network has been passed to a server (Column 4, lines 34-41).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified Cooper as modified with the teaching of Daly. This would allow the packet data services blacklist to include a flag indicating whether an identification of a blacklisted wireless network has been passed to a server for the purpose of database synchronization (mobile device and server).

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper (U.S. Patent Publication No. 2003/0129979) in view of Khare et al (U.S. Patent Publication No. 2002/0065067) and further in view of Yasushi et al. (U.S. Patent Publication No. 2002/0046285).

Referring to claim 3, Cooper as modified do not teach wherein the packet data services blacklist includes a composite packet data services blacklist received from a server.

However, Yasushi et al teach a method to maintain a composite list (data) which is based on the data sent to the server from mobile device to update the database (Paragraphs 0008- 0009).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified Cooper as modified with the teaching of Yasushi et al. The motivation would have been to update packet data services blacklist with the updated composite packet data services blacklist from the server.

5. Claims 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper (U.S. Patent Publication No. 2003/0129979) in view of Khare et al (U.S. Patent Publication No. 2002/0065067) and further in view of Yasushi et al. (U.S. Patent Publication No. 2002/0046285) and Daly (U.S. Patent No. 6122503).

Referring to claim 7, see the discussion of Cooper and Khare et al in Section # 2 above. Cooper teaches the method further comprising a step selected from the group consisting of: starting an age timer associated with a wireless network that is added to the packet data services blacklist and clearing

an age timer associated with a wireless network in response to satisfaction of a reset condition (Paragraph 0033).

Cooper and Khare et al do not teach the method of notifying a server of a newly blacklisted wireless network.

However, Yasushi et al teach a method where a mobile device communicates with server for updating and maintaining a database. The mobile device sends data to the server which is consolidated in the database at the server (Paragraph 0008).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified Cooper as modified with the teaching of Yasushi et al so that a mobile device would notify a server of a newly blacklisted wireless network. The motivation would have been to maintain an up-to-date composite blacklist at the server.

Cooper, Khare et al, and Yasushi et al also do not teach receiving a composite packet data services blacklist from a server.

However, Daly teaches a method which allows database information to be sent from server to a mobile station to update the database information within the mobile station (Column 4, lines 4-13).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified Cooper as modified with the teaching of Daly to receive composite packet data services blacklist from a

server. The motivation would have been to allow a mobile device to have its blacklist up-to-date and in sync with the server.

Referring to claim 9, see the discussion of Cooper and Khare et al in Section #2 above.

Cooper as modified does not teach sending a notification to the server if a mobile device finds a wireless network which was not previously providing packet data services to the mobile device and is now providing packet data services to the mobile device.

However, Yasushi et al teach a method of updating database in the server with the update condition received from various mobile units (Paragraph 8).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified Cooper as modified with the teaching of Yasushi et al. The motivation would have been to keep the composite blacklist in the server most up-to-date.

Cooper as modified also does not teach sending a notification from the server to other mobile devices to clear the entry of a wireless network which was previously not providing packet data services but currently is providing packet data services.

However, Daly teaches a method which allows database information to be sent from server to a mobile station to update the database information within the mobile station (Column 4, lines 4-13).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified Cooper as modified with the teaching of Daly. The motivation would have been to allow all mobile devices to have their blacklists up-to-date and in sync with the server.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper (U.S. Patent Publication No. 2003/0129979) in view of Khare et al (U.S. Patent Publication No. 2002/0065067) and further in view of Marran (U.S. Patent No. 6549770).

Referring to claim 8, see the discussion of Cooper and Khare et al in Section #2 above.

Cooper as modified does not teach the method of clearing the packet data services blacklist in response to a provisioning reset condition.

However, Marran teaches updating or correcting data stored in a mobile station under various conditions (Column 4, line 15-65; Column 5, line 1-50; Column 8, lines 30-50; Column 11, lines 10-45).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified Cooper as modified with the teaching of Marran. The motivation would have been to clear the packet data services blacklist in a mobile device by using a provisioning reset condition.

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tiedemann et al. (U.S. Patent No. 5642398) in view of Daly (U.S. Patent No. 6122503).

Referring to claim 10, Tiedemann et al. teach a method of packet data service notification in a wireless network, the wireless network including a server and a mobile device (Column 8 Lines 3-16), the method comprising: receiving at the server a registration of a newly powered-up mobile device (Column 10 Lines 24-30);

Tiedemann et al further teach about sending system, network, and zone information to facilitate mobile station operation across multiple systems and networks (Column 10, lines 55-67), but Tiedemann et al do not specifically teach retrieving a server-stored packet data services blacklist identifying wireless networks that do not provide packet data services to the newly powered-up mobile device; and sending the server-stored packet data services blacklist from the server to the newly powered-up mobile device for reception by and storage on the mobile device.

However, Daly teaches sending network information from server to a mobile station to update the database within the mobile station which is used to control the roaming operation (Column 4, lines 4-13).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified Tiedemann et al with the teaching of Daly to retrieve a server-stored packet data services blacklist

identifying wireless networks that do not provide packet data services to the newly powered-up mobile device; and sending the server-stored packet data services blacklist from the server to the newly powered-up mobile device for reception by and storage on the mobile device. The motivation for this modification would be to allow a mobile device to receive the packet data services blacklist from the server at the time of power-up registration to facilitate and control roaming operation across multiple networks.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DINESH GOEL whose telephone number is (571)270-5201. The examiner can normally be reached on Monday-Friday 8:00 AM-5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Ryman can be reached on 571-272-3251. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dinesh Goel/
Examiner, Art Unit 2419

/Daniel J. Ryman/
Supervisory Patent Examiner, Art Unit 2419